Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q61559	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 09/699,554	Filed October 31, 2000
	First Named Inventor Katsumi NIHEI	
	Art Unit 2611	Examiner Joseph G. USTARIS

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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June 2, 2006

Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Katsumi NIHEI

Appln. No.: 09/699,554

Confirmation No.: 7384

Filed: October 31, 2000

Docket No: Q61559

Group Art Unit: 2611

Examiner: Joseph G. USTARIS

For: ADVERTISEMENT METHOD, ADVERTISEMENT APPARATUS, ADVERTISMENT RECEIVER AND RECORDING MEDIUM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the

Examiner's Final Office Action dated March 2, 2006, Applicant files this Pre-Appeal Brief

Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

As of the final rejection of March 2, 2006, claims 1-3 stand rejected under 35 U.S.C. §

102(e) as allegedly anticipated by Zigmond (U.S. Patent 6,698,020). Claim 4 stands rejected

under 35 U.S.C. § 103(a) as allegedly unpatentable over Zigmond in view of Hendricks (U.S.

Patent 6,408,437). Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable

over Zigmond in view of Rakavy (U.S. Patent 6,317,789). Claim 13 stands rejected under 35

U.S.C. § 103(a) as allegedly unpatentable over Zigmond in view of Seth-Smith (U.S. Patent

4,866,770). For at least those reasons discussed below and those presented in Applicants'

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previous responses[1], Applicants submit that this rejection is improper, and reversal of the outstanding rejections is requested.

Brief Summary of the Cited References.

Zigmond describes a system for inserting advertisements into a video programming feed including an ad insertion device 80 (Abstract; Figs. 3 and 5). According to Zigmond, an ad delivery source delivers ads to the ad insertion device 80. The ads may be "pre-screened" by an ad filter 84, which uses selection criteria 83 to select ads which are to be stored in an advertisement repository 86 and those which are discarded (col. 15, lns. 17-23). The stored advertisements are then selected for presentation to a viewer according to selection criteria (col. 17, lns. 24-25).

Hendricks describes a reprogrammable terminal which suggests programs for viewing through television systems. The terminal applies a method of analysis to suggest programs to a user. The method may include a responsive method in which a user is asked to respond to a series of questions and an intelligent method in which the terminal "learns" a user's viewing choices through analysis of historical data (Abstract; col. 2, ln. 52 – col. 3, ln. 40).

Rakavy describes a method and system for transmitting personalized advertisements from a network to a local computer with minimal interference with other data transmitted between the network and local computer. The content of the advertisements transmitted to the local computer may be determined based on user preference information (Abstract; col. 2, ln. 66 – col. 3, ln. 51).

Seth-Smith describes a communication system which enables transmission of individual teletext messages to individual network subscribers (Abstract).

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[1] See Amendment under 37 C.F.R. § 1.116 filed April 26, 2005, and Response under 37 C.F.R. § 1.111 filed December 21, 2005.

None of the cited references teaches or suggests: a) receiving advertisement data and storing received advertisement data that meets selection standards; and b) assigning an evaluation value to the stored advertisement data.

As noted in Applicants' responses[2], independent claims 1, 9, 11, and 12 each recite two distinct limitations. First, selection standards are set and received advertisement data which meets the selection standards is stored.[3] Second, evaluation values are assigned to the stored advertisement data and the stored advertisement data is presented to the user in order of highest evaluation value.[4] These are two separate limitations.

Zigmond. In the Office Actions of the present Application, the Examiner asserts that Zigmond discloses both of the above-noted distinct limitations. The Examiner refers to the "pre-screening" of the ad filter of Zigmond as disclosing the claimed "selection standards" by which received advertisement data is stored, and then asserts that "[t]he filtered advertisements within the advertisement repository [of Zigmond] are inherently 'assigned an evaluation value' wherein the filtered advertisements meet the 'selection standards' of what the viewer wishes to receive." Further, the Examiner asserts that "[a]ny other advertisement that do not meet the 'selection standards' are not stored…, thus having no 'evaluation value'." The Examiner then asserts that "[t]he filtered advertisements are then 'extracted' from the repository and presented to the viewer ' in the order of highest evaluation value' for meeting the 'selection standards' than the

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[2] April 26 Amendment, pages 11-12; December 21 Response, pages 2-3.

3 "[A]t a reception end, setting selection standards for a receive time, a receive position and preference of the user, selecting advertisement data which satisfy said standards from the received advertisement data, and storing the selected advertisement data in a received advertisement data base," claim 1, see also claims 9, 11, and 12.

4 "[A]t the reception end, assigning an evaluation value to the stored advertisement data based on a reproduction time, a reproduction position and preference of said user, extracting the advertisement data in order of highest evaluation value, and presenting said extracted advertisement data to the user in order of highest evaluation value," claim 1, see also claims 9, 11, and 12.

advertisements that weren't stored because those advertisements did not meet the 'selection standards'."[5]

Independent claims 1, 9, 11, and 12 each clearly recite that an evaluation value is assigned to stored advertisement data, that is, advertisement data which has already been selected for storage based on the "selection standards." In other words, there is a two-tiered selection process: first, received data is separated into stored data and not stored data based on the "selection standards." Second, the *stored* data is assigned an evaluation value and presented in order of highest evaluation value. Even if Applicants were to assume, arguendo, that the function of the ad filter of Zigmond discloses "selection standards" as asserted by the Examiner, there is no teaching or suggestion that the ad filter's "pre-screening" process acts on stored advertisement data. In fact, it is clearly described in Zigmond that the function of the ad filter is to determine those ads which are to be stored.

Further, to the extent that the Examiner asserts that the assignment of an evaluation value and the presentation of advertisements in order of highest evaluation value is inherent to the disclosure of Zigmond, Applicants respectfully disagree. Applicants submit that the disclosure of Zigmond does not necessarily require the assignment of an evaluation value which determines the order of presentation of the advertisement data, as claimed.[6] Rather, Zigmond merely discloses that certain criteria are used to select an advertisement for presentation. Accordingly, if a viewer wishes to view only advertisements related to automobile manufacturers, for example,

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[5] March 2, 2006 Office Action, pages 2-3; see also September 21, 2005 Office Action, page 3.

[6] Evidence of inherency in a reference "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

the criteria could require that only an advertisement for an automobile manufacturer be selected for display. This neither teaches nor necessitates the assignment of an evaluation value, as claimed.[2]

<u>Hendricks, Rakavy, and Seth-Smith.</u> As previously submitted by Applicants[8], none of Hendricks, Rakavy, and Seth-Smith remedy the above-discussed deficiencies of Zigmond.

Conclusion.

In view of the foregoing, and in view of the arguments advanced above, Applicants submit that the Examiner has failed to establish a *prima facie* case regarding any of rejected claims 1-4 and 8-13. Therefore, claims 1, 9, 11, and 12 are patentable over the cited references and claims 2-4, 8, 10, and 13 are patentable at least by virtue of their dependence on claims 1 and 9. Applicants respectfully request reconsideration of the final Office Action and withdrawal of the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a).
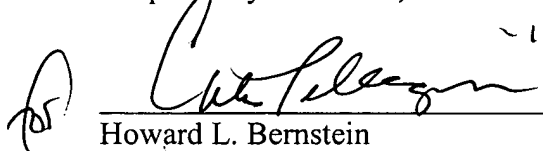
Respectfully submitted,

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Date: June 2, 2006

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[2] Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. (citing In re Oelrich, 666 F. 2d 578, 581

[8] April 26 Amendment, pages 13-14; December 21 Response, pages 3-4.